



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,400	01/17/2002	Ronald D Townsend	108382-05	1285

27189 7590 06/27/2006

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
530 B STREET
SUITE 2100
SAN DIEGO, CA 92101

EXAMINER

FERGUSON, DENISE

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,400

Applicant(s)

TOWNSEND ET AL.

Examiner

Denise Ferguson

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final office action in response to the communication received on January 17, 2002. Claims 1-16 are now pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 8, 11, 12-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoemaker et al. (US Publication No. 2003/0167197 A1) in view of Vallaire (US Patent No. 5971273).
4. As per claim 1, Shoemaker et al. disclose a method of generating indefinite revenue streams in a retail industry (fig. 7 shows the system in use within the retail industry as product sales are referenced in the user interface), comprising the steps of:
 - automatically sending from a remote server a personalized action electronic communication to a client computer of a customer, the personalized electronic communication including questions for the customer (par. 0005, Web surveys are created and distributed to customers);
 - receiving at a client computer of a sales representative answers to the questions of the personalized action electronic communication from the retail customer (par. 0033; Survey responses are sent to a central computer through a network and stored in a database. par. 0036-0037; An account management tool allows account management representatives to view survey results).

- generating indefinite revenue streams from the answers to the questions of the personalized action electronic communication (par. 0003; Shoemaker et al. discloses that promptly addressing survey responses it is critical to company success).
5. Shoemaker et al. do not expressly disclose the electronic communication sent to a client computer of a customer on every anniversary of a purchase date. However, Vallaire discloses an automated system that utilizes customer data to distribute promotions or reminder systems for annually repeating events such as birthdays or anniversaries (col. 3, lines 33-42).
 6. Shoemaker et al. and Vallaire are both directed toward promotional marketing campaigns, and their combination produces a system that increases sales through customer communication, customer research, and product promotion.
 7. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Shoemaker et al. an electronic communication to a client computer of a customer on every anniversary of a purchase date in order to promote products and market to customers periodically since Vallaire discusses this type of promotion as a valuable marketing tool as suggested in col. 3, lines 32-42 of Vallaire.
 8. As per claim 2, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above, but do not expressly disclose the method of claim 1, wherein an anniversary of a purchase date includes a monthly anniversary.
 9. Official notice is taken that an anniversary may occur at any time interval. For example, an anniversary may occur annually, semi-annually, quarterly, monthly, weekly, etc.
 10. Since the Shoemaker et al. and Vallaire combination teaches the concept of sending promotional material on an anniversary as discussed above, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate in the method of claim 1 an anniversary of a purchase date that includes a monthly anniversary in order to

facilitate future customer contact and marketing. Vallaire discusses this type of promotion as a valuable marketing tool (col. 3, lines 32-42). Additionally, monthly contact with a customer would in many cases be preferred to only annual contact since more frequent communication would provide the company with more data to track and utilize customer satisfaction, requirements, demand, and referrals over time.

11. As per claim 4, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above. Shoemaker et al. further disclose the method of claim 1 wherein the questions of the personalized action electronic communication include a link to a web page on a remote server (par. 0005).
12. As per claim 8, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above. Shoemaker et al. also disclose the personalized action electronic communication includes at least a customer name, a business establishment name, and a sales representative name (fig. 7, #132; par. 0037; The system display includes the customer name, the customer account name, and the account manager).
13. As per claim 11, Shoemaker et al. in view of Vallaire discloses the method of claim 1 as discussed above. Shoemaker et al. further discloses providing an administrator function to at least one of
 - add new retail establishments (par. 0020; The system includes administration functions that enable the user to add a new account. fig. 3 shows multiple survey respondents for an account. fig. 2 and fig. 7 show that an account can be a retail establishment),
 - and create administration manager users for retail establishments (par. 0017-0018; An account manager is assigned to each account for account management and administration, and managers are provided with access to account information based on

their particular clearance level. fig. 3 shows multiple survey respondents for an account.

fig. 2 and fig. 7 show that an account can be a retail establishment),

14. As per claim 12, Shoemaker et al. in view of Vallaire discloses the method of claim 1 as discussed above. Shoemaker et al. further disclose providing an administrative manager function to at least one of

- create or delete sale representatives or basic users (par. 0020-0021; The system includes administration functions that enable the user to add and delete a new customer and customer account information),
- assign or unassign customers to sales representatives (par. 0017; The system allows an account manager to be assigned to each customer account. par. 0021; The system allows account information updates),
- and view all customers currently assigned to a sales representative (fig. 2, par. 0019; The account listing page shows all customer accounts assigned to the selected account manager).

15. As per claim 13, Shoemaker et al. in view of Vallaire discloses the method of claim 1 as discussed above. Shoemaker et al. further disclose providing a sales representative function to at least one of

- view customers that need to be contacted on a specific day (fig. 7, par. 0040; The action plan implementation, such as a meeting with the customer, is scheduled for future reference and follow-up),
- enter or edit information for a customer (par. 0020-0021; The system provides the ability to add and update customer account information),

Art Unit: 3623

- view all customers currently assigned to a sales representative (fig. 2, par. 0019; The account listing page shows all customer accounts assigned to the selected account manager).
16. Shoemaker et al. do not expressly disclose a function to view customers that have been sent a personalized action electronic communication, or view or edit referrals of a customer.
17. It is an old and common practice in the art of customer relationship management to provide customer information system users the ability to store customer or other associated data in a database, query the data based on desired criteria such as the status of customer contact, and view or edit data such as prospective customer contact information.
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Shoemaker et al. a feature that allows the user to view customers that have been sent a personalized action electronic communication, or view or edit referrals of a customer in order to determine the customer communication status, and to provide the ability to easily update and correct customer information. Shoemaker et al. discuss the advantage of maintaining current and accurate customer data to enhance customer communication and relationships (par. 0004).
19. As per claim 14, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above. Shoemaker et al. further discloses including providing a basic function to create customer records (par. 0020-0021; The system provides the ability to add customer account information).
20. As per claim 16, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above. Shoemaker et al. further disclose that the personalized action electronic communication is an e-mail (par. 0005).

21. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoemaker et al. (US Publication No. 2003/0167197 A1) in view of Vallaire (US Patent No. 5971273), and further in view of Slotznick (US Patent No. 5983200).
22. As per claim 3, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above. Shoemaker et al. further disclose automatically sending from the remote server an electronic reminder to contact the customer to a client computer of a sales representative (par. 0005; An action plan is generated to address customer issues and needs and is accessible to account managers. fig. 7 shows a sample Proposed Action Plan in which a Sales Representative initiates contact with a customer. par. 0043; The Action Plan is stored in a database for future reference in subsequent action planning).
23. Shoemaker et al. do not expressly disclose automatically sending from the remote server an electronic reminder to call the customer to a client computer of a sales representative on every monthly anniversary of a purchase date of the retail customer.
24. However, Slotznick discloses a system that facilitates e-mail communication. The system serves as an intelligent agent that electronically sends a reminder to a user to carry out a task (col. 2, lines 28-29; Some communication software allows scheduling of future email message transmissions. col. 3, lines 50-52; The system user can delegate tasks to be accomplished repeatedly in the future).
25. Although Slotznick does not expressly disclose a reminder to call a customer, the system can be used to send an electronic communication to any user a reminder to complete any task. That the claimed method is utilized to electronically send a reminder to Sales Representative to call a customer does not distinguish the claim over the prior art since the intended field of use does not change the overall functionality of the method. The intended use must result in manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

26. Accordingly, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to include in the method of claim 1 an electronic reminder to call a customer to a client computer of a sales representative in order to promptly resolve identified issues and enhance the relationship with the customer. Shoemaker et al. discuss the importance of rapid response to customer issues in satisfying and retaining the customer (par. 0003).
27. Since the Shoemaker et al. and Vallaire combination teaches the concept of sending promotional material on an anniversary as discussed above, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate in the method of claim 1 a reminder to call the customer on a monthly anniversary of a purchase date of the retail customer in order to facilitate future customer contact and marketing. Vallaire discusses this type of promotion as a valuable marketing tool (col. 3, lines 32-42). Additionally, monthly contact with a customer would in many cases be preferred to only annual contact since more frequent communication would provide the company with more data to track customer satisfaction, requirements, demand, and referrals over time.
28. Claims 5-7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoemaker et al. (US Publication No. 2003/0167197 A1) in view of Vallaire (US Patent No. 5971273), and further in view of Luth et al. (US Patent No. 6446044 B1).
29. As per claim 5, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above, but do not disclose that at least some of the answers to the questions of the personalized action electronic communication include customer referrals, and sales are generated from the customer referrals.
30. However, Luth et al. disclose a system that is also drawn to promotion through referrals with the goal of increasing visibility among prospective users. The system of Luth et al. prompts the user to submit referrals and their contact information (col. 3, lines 43-55). In addition, it is

an old and common practice in the retail industry to develop and implement customer referral programs to generate sales.

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include customer referral requests in the electronic communication in order to efficiently and cost-effectively advertise to a large number of consumers. Luth et al. disclose that the advantage of implementing a referral program is to advertise to and attract additional users (col. 1, lines 38-41).
32. As per claims 6 and 7, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above, but do not disclose that the personalized action electronic communication is personalized in accordance with at least one of the interests, and the personalized action electronic communication includes an interest or hobby theme that varies with each personalized action electronic communication.
33. However, Luth et al. disclose a system that collects personal information specific to a user, such as hobbies and interests, and uses that information to define target groups and determine target criteria to determine the appropriate communication to send the various users (col. 3, lines 10-13).
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include personalized electronic communication that includes an interest or hobby theme that varies with each personalized action electronic communication in order to draw attention to the communication and increase the probability of responses. Luth et al. discuss that the advantage of personalizing electronic communication is to increase the number of users who are likely to respond with quality responses (col. 6, lines 51-60).

35. As per claim 9, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above, but do not disclose that at least one of the questions of the personalized action electronic communication asks for potential new customers.
36. However, Luth et al. disclose a system that is also drawn to promotion through referrals with the goal of increasing visibility among prospective users. The system of Luth et al. includes a user survey and requests the contact information of referral users (col. 3, lines 43-55).
37. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include customer referral requests in the electronic communication in order to efficiently and cost-effectively advertise to a large number of consumers. Luth et al. discloses that the advantage of implementing a referral program is to improve the efficiency and reduce cost in advertising (col. 1, lines 38-41).
38. As per claim 10, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above, but do not disclose that the customer is rewarded for referring a customer.
39. However, Luth et al. disclose a system and method that is also drawn to promotion through referrals with the goal of increasing visibility among prospective users. The system of Luth et al. includes a user reward for referring another user (col. 5, lines 10-12; The user is offered incentives for referring potential new users. col. 5, lines 52-53; The referral process continues indefinitely as new users, as well as current users, continue to contact further potential users).
40. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a referral incentive program in order to efficiently and cost-effectively advertise to a large number of consumers. Luth et al. discloses that the advantage of implementing a referral program is to improve the efficiency and reduce cost in advertising (col. 1, lines 38-41).

41. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoemaker et al. (US Publication No. 2003/0167197 A1) in view of Vallaire (US Patent No. 5971273), and further in view of Montoya (US Publication No. 2001/0047292 A1).
42. As per claim 15, Shoemaker et al. in view of Vallaire disclose the method of claim 1 as discussed above, but do not disclose that the retail industry is the automotive retail industry.
43. However, Montoya discloses an automated system and a method drawn to collecting and utilizing customer satisfaction and related customer data. The system collects and disseminates survey information for use in the automotive retail industry (par. 0008, par. 0015). In addition, the claimed method can be utilized in any industry. That the claimed method is utilized in the automotive retail industry does not distinguish the claim over the prior art since the intended field of use does not change the overall functionality of the method. The intended use must result in manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).
44. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the claimed method in the automotive retail industry in order to collect automotive retail customer data and prospective customer referrals from current or previous customers. Montoya discloses that the advantage of periodically collecting customer opinion is the company's ability to continuously update and utilize customer data (par. 0014). This provides the company with improved data quality for business strategy and planning.

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Gorelick et al. (US Publication No. 2002/0072968 A1) discuss a method for providing purchasing incentives to customers.

Art Unit: 3623

- Bell et al. (US Patent No. 6574606 B1) discuss a method and system for marketing products to customers via the Internet.
- Oran (US Patent No. 6968313B1) discusses a method and apparatus for facilitating and tracking referrals.
- Libman (US Patent No. 6999938 B1) discusses a system for customizing and automatically distributing communications to clients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise Ferguson whose telephone number is (571) 272-6392. The examiner can normally be reached on Monday - Friday, 8 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DF
DF

06/23/2006

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER

AU 3623